

Question Q217

National Group: Peru

Title: The patentability criterion of inventive step / non-obviousness

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Questions

I. Analysis of current law and case law

The Groups are invited to answer the following questions under their national laws:

Level of inventive step / non-obviousness

1. What is the standard for inventive step / non-obviousness in your jurisdiction? How is it defined?

According to our legislation, an invention shall be regarded as involving an inventive step if, for a person in skilled in the technical field concerned, said invention is neither obvious nor obviously derived from the state of the art.

Inventive step is understood as a creative process, the results of which are not derived for the state of the art in a manner evident for a person skilled in the art, at the time of the filing date or priority date. When determining the inventive step of an invention, the differences between the invention and the prior art must be considered and the Examiner must not only limit himself to tell the differences between both but, in case of objection, must demonstrate that the same lacks inventive step.

2. Has the standard changed in the last 20 years? Has the standard evolved with the technical / industrial evolution of your jurisdiction?

The inventive step standard has not change in the last 20 years. The Patent Office has been using the same standard mentioned above.

3. Does your patent-granting authority publish examination guidelines on inventive step / non-obviousness? If yes, how useful and effective are the guidelines?

Our Patent Office does not publish the guidelines used. However the Patent Office uses the guidelines given by the Andean Community, to which Peru belongs, and those can be found in the Andean Community's web page. These guidelines mainly follow WIPO's guidelines.

4. Does the standard for inventive step / non-obviousness differ during examination versus during litigation or invalidity proceedings?

No, the same guidelines are used, regardless of the proceeding.

Construction of claims and interpretation of prior art

5. How are the claims construed in your jurisdiction? Are they read literally, or as would be understood by a person skilled in the art?

The claims should be written in a way that they are clear for the Examiner, form the lecture of the same. The meaning and scope of the claims is the one normally given in the technical filed of the invention. However, if a different meaning is given, the same should be clearly defined in the specification and, if possible, within the claim.

6. Is it possible to read embodiments from the body of the specification into the claims?

The claims should not refer to the specification or the drawings. The claims should be clear enough to be understood without support on the specification. All the essential characteristics of the invention shall be described in the independent claims and any additional characteristics shall be added in the dependent claims.

7. How is the prior art interpreted? Is it read literally or interpreted as would be understood by a person skilled in the art? Is reliance on inherent disclosures (aspects of the prior art that are not explicitly mentioned but would be understood to be present by a person skilled in the art) permitted?

According to the guidelines followed by the Patent Office, the prior art must always be analyzed in its context, it shall not be extracted and analyzed outside of the same. It could contain implicit information, that is, all information that can be derived, directly and without ambiguity from the document, by the person skilled in the art.

8. Do the answers to any of the questions above differ during examination versus during litigation?

No, since both prosecution and litigation are handled by the Patent Office, the same guidelines are used during both.

Combination or modification of prior art

9. Is it proper in your jurisdiction to find lack of inventive step or obviousness over a single prior art reference? If yes, and assuming the claim is novel over the prior art

reference, what is required to provide the missing teaching(s)? Is argument sufficient? Is the level of the common general knowledge an issue to be considered?

Yes, in the case of selection inventions a single document is sufficient to find lack of inventive step. In the case of selection inventions, it must be demonstrated an unexpected or improved effect. In some cases it is enough to file arguments demonstrating the unexpected or improved effect, however it is generally required to file data or essays demonstrating the same. The level of the common general knowledge is to be considered, such as in the case of polymorphs, which do not demonstrate the unexpected effect of the crystals versus the compound.

10. What is required to combine two or more prior art references? Is an explicit teaching or motivation to combine required?

It is required that said combination be obvious to the person skilled in the art. It is understood that the combination of two or more prior arts is not obvious for a person skilled in the art unless said combination was defined as possible within any of the documents. As general rule, no more than two documents shall be used to analyze the inventive step of the invention. However, an exception to this rule is the situation in which the juxtaposition of characteristics, each one producing its own effect and without an effect in the combination of the same. In this case it is permissible to combine more than two documents, where each document is relevant for each of the juxtaposed characteristics.

11. When two or more prior art references are combined, how relevant is the closeness of the technical field to what is being claimed? How relevant is the problem the inventor of the claim in question was trying to solve?

Generally, only two or more prior art references can be combined to determine the existence of inventive level. To determine if the subject matter of a claim is obvious or is derived from the state of the art, the Examiner usually relies on the problem-solution method. Then, the following stages must be followed: identify the nearest state of the art, identify the technical characteristics of the invention that differ from the prior art, and define the technical problem to be solved based on the nearest prior art.

12. Is it permitted in your jurisdiction to combine more than two references to show lack of inventive step or obviousness? Is the standard different from when only two references are combined?

Yes it is possible to combine more than two references in some cases (view question 10).

13. Do the answers to any of the questions above differ during examination versus during litigation?

No, the answers do not differ whether the proceeding is the examination of the application or litigation.

Technical Problem

14. What role, if any, does the technical problem to be solved play in determining inventive step or non-obviousness?

As explained above, the problem-solution method is used by the Examiner in every case; therefore the technical problem to be solved has an important role in determining the inventive step of an invention.

15. To what degree, if any, must the technical problem be disclosed or identified in the specification?

Our legislation states that the description of the invention must be clear enough, so that the technical problem and the solution proposed be understood. Even though it is not a strict requirement that the technical problem be disclosed in the specification, it is strongly suggested that the same be included.

Advantageous effects

16. What role, if any, do advantageous effects play in determining inventive step or non-obviousness?

An advantageous effect is an indication to identify the existence of inventive step in an invention.

17. Must the advantageous effects be disclosed in the as-filed specification?

It is preferable that the advantageous effects be disclosed in the as-filed specification.

18. Is it possible to have later-submitted data considered by the Examiner?

If data were not originally disclosed, comparative essays or results form essays demonstrating advantageous effects may be filed during the examination proceedings and usually the same are accepted and considered by the Examiner when evaluating the inventive step or the invention.

19. How “real” must the advantageous effects be? Are paper or hypothetical examples sufficient?

Generally, hypothetical examples are not enough to convince the Examiner that an invention has inventive step. It is preferable that the applicant files comparative data or the results form essay made by the applicant.

20. Do the answers to any of the questions above differ during examination versus during litigation?

No, the answers do not differ whether the proceeding is the examination of the application or litigation.

Teaching away

21. Does your jurisdiction recognize teaching away as a factor in favor of inventive step / non-obviousness? Must the teaching be explicit?

Yes, our jurisdiction recognizes teaching away as a factor of inventive step/non obviousness. Yes, the teaching must be explicit. According to our guidelines, any objection regarding the invention's inventive step must be proved on the basis of the state of the art.

22. Among the other factors supporting inventive step / non-obviousness, how important is teaching away?

Teaching away is important but not a determining factor in support of inventive step. The most important aspect to determine whether an invention involves inventive step is to demonstrate the advantages or unexpected effect of the invention.

23. Is there any difference in how teaching away is applied during examination versus in litigation?

No, the answers do not differ whether the proceeding is the examination of the application or litigation.

Secondary considerations

24. Are secondary considerations recognized in your jurisdiction?
25. If yes, what are the accepted secondary considerations? How and to what degree must they be proven? Is a close connection between the *claimed* invention and the secondary considerations required?
26. Do the answers to any of the questions above differ during examination versus during litigation?

Other considerations

27. In addition to the subjects discussed in questions 4 - 26 above, are there other issues, tests, or factors that are taken into consideration in determining inventive step / non-obviousness in your jurisdiction?
If yes, please describe these issues, tests, or factors.

The claims should be limited to values which have demonstrated industrial activity, by way of the examples filed within the specification, or by providing additional data when responding to the Examiner.

Test

28. What is the specific statement of the test for inventive step/non-obviousness in your jurisdiction? Is there jurisprudence or other authoritative literature interpreting the meaning of such test and , if so, provide a brief summary of such interpretation.

There is no jurisprudence in our country. The Patent Office considers the information provided by the applicant, that is the examples filed in the specification or the data filed at a later date, to be truthful and will rely in the same.

29. Does such test differ during examination versus during litigation?

During litigation, the applicant must file information not only of the patented product but of the infringer product as well, so that the Patent Office can make a comparison between both products.

Patent granting authorities versus courts

- 30. If there are areas not already described above where the approach to inventive step / non-obviousness taken during examination diverges from that taken by courts, please describe these areas.
- 31. Is divergence in approach to inventive step / non-obviousness between the courts and the patent granting authority in your jurisdiction problematic?

Regional and national patent granting authorities

- 32. If you have two patent granting authorities covering your jurisdiction, do they diverge in their approach to inventive step / non-obviousness?

Our country only has one patent granting authority: INDECOPI

- 33. If yes, is this problematic?

Not applicable

II. Proposals for harmonization

The Groups are invited to put forward proposals for the adoption of harmonised rules in relation to the patentability criteria for inventive step / non-obviousness. More specifically, the Groups are invited to answer the following questions without regard to their national laws:

- 34. Is harmonization of inventive step / non-obviousness desirable?

Yes, we believe it is necessary to harmonize the criteria used to identify the inventive step of an invention.

- 35. Is it possible to find a standard for inventive step / non-obviousness that would be universally acceptable?

We believe it would be difficult to have a single universal standard for inventive step.

- 36. Please propose a definition for inventive step / non-obviousness that you would consider to be broadly acceptable.

The invention must solve a technical problem in an unexpected way. The problem-solution method should be used when evaluating the inventive step of an invention.

- 37. Please propose an approach to the application of this definition that could be used by examiners and by courts in determining inventive step / non-obviousness.

The technical problem should be identified, then the nearest prior art should be evaluated to identify the differences between both and lastly the Examiner should verify if the differences were not taught or suggested in the prior art and if the same solve the technical problem.